

Notice of Allowability

Application No.

10/534,584

Examiner

Zinna Northington Davis

Applicant(s)

BLURTON ET AL.

Art Unit

1625

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Preliminary Amendment & IDS filed May 11, 2005 and the Response filed April 3, 2008.
2. ☒ The allowed claim(s) is/are 1-9 and 11 (now renumbered as 1-10, respectively).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 05/11/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Ms Sylvia A. Ayler on July 23, 2008.
3. The application has been amended as follows:
 - A. At Claim 4, 1st line, the phrase "according to claim 1, or 2 or 3" has been amended to read in favor of:
-- according to claim 1--.
 - B. At Claim 5, 1st line, the phrase "according to any preceding claim" has been amended to read in favor of:
-- according to claim 4--.
 - C. At Claim 6, 1st line, the phrase "according to any preceding claim" has been amended to read in favor of:
-- according to claim 1--.
 - D. At Claim 7, 1st line, the phrase "according to any preceding claim" has been amended to read in favor of:
-- according to claim 1--.
 - E. At Claim 8, 2nd line, the phrase "according to any preceding claim" has been amended to read in favor of:

-- according to claim 1--.

F. At Claim 9, 1st and 2nd line, the phrase "according claim1" has been amended to read in favor of:

-- according to claim 1--.

G. Claim 11 has been amended to read in favor of:

-- 11. (Amended) A method for the treating pain, which method comprises administration to a patient in need thereof of an effective amount of a compound of formula (I) according to claim 1, or a pharmaceutically acceptable salt or N-oxide thereof.--.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

4. In the response filed April 3, 2008, Applicants have elected Group I, claims 1-9, with traverse. Applicants request rejoinder of the withdrawn method claims.
5. Based upon rejoinder practice, claim 11 has been amended to include a method for treating pain. At pages 61-63, support of the activity of the chemical compound is found.
6. Applicants preserve the right to file divisional applications drawn to the non-elected subject matter of claim 11.
7. The Amendments (A-F) are editorial in nature. The changes are not made to avoid any possible rejections based upon prior art.
8. The Information Disclosure Statement filed May 11, 2005 has been considered. The references alone or in combination forms do not teach nor suggest structurally

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similar compounds as the instantly claimed invention. There is no motivation to modify the prior art compounds to derive the compounds as claimed. Accordingly, claims 1-9 and 11 are allowed.

9. Bold et al. has been cited to show the state of the art.

10. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Zinna Northington Davis/
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